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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,012	03/19/2007	Roberto Tosi	502343.117530	6961
29540	7590	09/13/2010		
DAY PITNEY LLP 7 TIMES SQUARE NEW YORK, NY 10036-7311			EXAMINER TAOUSAKIS, ALEXANDER P	
			ART UNIT 3726	PAPER NUMBER
			NOTIFICATION DATE 09/13/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/581,012	Applicant(s) TOSI, ROBERTO	
	Examiner ALEXANDER P. TAOUSAKIS	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/10/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 10-15 in the reply filed on 08/10/2010 is acknowledged. The traversal is on the ground(s) that Douglas is not prior art and wheel balancing is not well known. This is not found persuasive because wheel balancing is well known in the art. Note that Group I only requires checking the balance of a vehicle. An example of such a process is shown in Gold (4,285,240) (*see Abstract*), in Rothamel et al (5,591,909) (*see Abstract*), in Diez (5,983,717) (*see Abstract*) among others. None of these references teach comparing an unbalance to a determined mass, which is required in Group II. Therefore Group II has a special technical feature over the combination of any of the above references in view of Barret et al (2003/0050127).

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 10-15 are objected to because of the following informalities:

Claims 10-15: All references numerals should be removed.

In Claim 10:

In line 1, "System" should be changed to ---A system---.

In line 3, "the system comprising" should be removed because it is redundant and "carrying out finishing" should be changed to ---carrying out a finishing---.

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In line 8, "the system being characterised by comprising" should also be removed.

Note that line 2 of claim 10 already has the phrase "the system comprising."

Claims 11-15: In line 1, "System" should be changed to ---The system---.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goebel (20020148276) in view of Wehde et al (3,259,730).

10. Goebel teaches a system for producing alloy wheels for motor vehicles (*see Figure 1 and [0018]*), the system comprising:

a means for detecting the unbalance of said wheel and means for checking whether said unbalance falls within an unbalance acceptability value (see [0018]);

means for calculating a mass to be added and the respective phase with respect to a determined point on the wheel (see [0010]);

said unbalance being identified by said mass and by said phase and having a means for calculating a first mass and a second mass (13, 14) to be added and the respective first and second phase with respect to a determined point of the wheel, said first and second mass being separated from each other along the axle of the wheel (see *Figure 2, [0020]-[0021], where it discloses two masses located in different planes/phases*).

Goebel et al fails to teach a cutting machine tool and calculating a mass to be removed.

Wehde et al teaches a cutting machine tool, a laser removing tool, for carrying out a finishing operation and determining a mass to be removed (see *Figure 1 and column 1 lines 21-28*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to remove mass from the wheel of Goebel instead of adding, as taught by Wehde et al, because it's cost effective and a more reliable method for balancing, as weights added may become disconnected (see *Wehde et al column 1 lines 63-67*).

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11. Goebel/Wehde et al teach the system according to claim 10, characterized by comprising means for calculating a first and second simulated mass to be removed from the wheel to correct the unbalance of the wheel in working condition and the respective simulated phase (*see [0010-0011]*).

12. Goebel/Wehde et al teach the system according to claim 11, characterized by comprising means for checking the first and second simulated mass of the unbalance acceptability with respect to a first and second unbalance acceptability value (*see [0011][0012]*).

13. Goebel/Wehde et al teach the system according to claim 12, characterised by comprising a cutting machine tool for removing said simulated mass from said wheel to compensate the unbalance, when at least one of the first and second masses is not lower than the respective first and second unbalance acceptability values (*see Goebel [0012 [0014], and Wehde et al column 1 lines 21-28]*).

14. Goebel/Wehde et al teach the system according to claim 13, characterised in that said cutting machine tool comprises sensors (10, 11) for detecting unbalance (*see [0018]*), a control unit for calculating the first and second simulated mass the respective first and second phase and the first and second coordinates of said first and second simulated mass (*see Figure 1 and [0018-0021]*) and a numerical control suited to acquire said coordinates (*see [0008-0009] where it discloses an evaluation device,*

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which works as both a control unit and a numerical control as it obtains information from the sensors and produces corresponding forces and simulated masses); said cutting machine tool being suited to carry out the machining finishing operation, to check the unbalance and eventually to remove the first and second simulated mass (see Goebel [0010] and Wehde et al column 1 lines 21-28).

15. Goebel/Wehde et al teach the system according to claim 13, characterised in that said cutting machine tool (24) comprises a sensors for detecting the dynamic unbalance and means for calculating the first and second mass in correspondence of a first and a second plane along the axis of said wheel (see Wehde et al column 1 lines 21-28 and Geobel [0010-0011]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER P. TAOUSAKIS whose telephone number is (571)272-3497. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander P Taousakis
Examiner
Art Unit 3726

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